

The opinion in support of the decision being entered today was **not** written for publication and is **not** precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LYN E. BRIGHT

Appeal No. 1998-0483
Application No. 08/543,840

ON BRIEF

Before CALVERT, FRANKFORT, and LAZARUS, Administrative Patent Judges.

LAZARUS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 13 and 15 through 18. Claim 14, the only other claim, stands allowed.¹

We affirm-in-part and add a new ground of rejection.

¹ The examiner's communication mailed December 8, 1997 (Paper No. 15) indicates that applicant's amendment filed November 21, 1997 (Paper No. 14) has been entered and claim 14 is allowable.

THE INVENTION

The appellant's invention relates to a method of applying an elastic label to a container (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.²

Claim 1 is illustrative of the subject matter in issue and reads as follows:

A method of applying an elastic segment of sheet material having a leading end and a trailing end unattached to the leading end to the surface of an article, said method comprising:

stretching the segment to elastically deform the label and increase the distance between the leading and trailing ends,

applying said segment while so stretched to the article by adhering the leading end of the stretched segment to the article with a fast acting adhesive which substantially adheres the leading end of the stretched segment to the article while the stretched segment is in an elastically deformed condition, wrapping the stretched segment around said article and securing the trailing end of the stretched segment to said leading end or to the article, whereby said segment as applied to the article is in the elastically deformed condition.

² The claims in the appendix are correct with the exception of claim 14 which, as noted in the previous footnote, was amended subsequent to submission of the appellant's brief and appendix.

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THE PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Herdzina et al. (Herdzina)	4,216,044	Aug. 5,
1980		
Dickey	4,923,557	May 8,
1990		

THE REJECTIONS

Claims 1 through 6 and 12 through 18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 through 13 and 15 through 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dickey in view of Herdzina.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted

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rejections, we make reference to the examiner's answer (Paper No. 12, mailed September 16, 1997) for the complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 11, filed July 24, 1997) and reply brief (Paper No. 13, filed November 21, 1997) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The 35 U.S.C. § 112, second paragraph, rejection.

We cannot sustain the examiner's rejection of appellant's claims 1 through 6 and 12 through 18 under 35 U.S.C. § 112.

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The examiner in rejecting claims 1 through 6 and 12 through 18 under the second paragraph of 35 U.S.C. § 112 points out that "[t]he language 'fast acting adhesive' which appears in each of independent claims 1 and 12 renders the claims indefinite for being overly subjective and not being representative of any definite type of adhesive" (final rejection, page 2).

Appellant's response argues that the wording of each of independent claims 1 and 12 describes how the fast acting adhesive is used, and in doing so satisfies the Section 112 requirement that a claim reasonably apprise those of skill in the art of its scope (brief, pages 7-8).

A decision as to claim indefiniteness requires a determination of whether those skilled in the art would understand what is claimed. See Amgen Inc. v. Chugai Pharmaceutical Co., 927 F.2d 1200, 1217, 18 USPQ2d 1016, 1030 (Fed. Cir. 1991).

We note that although the present specification does not

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utilize the terminology "fast acting adhesive," it does describe that the adhesive "bonds very quickly and strongly to the label and to the container, such that it prevents or minimizes relaxation of the label as it leaves the vacuum drum and bonds to the container" (specification, page 3, lines 22-25). Additional explanation is provided that "[t]o prevent the label from slipping on the container due to its greater peripheral speed, an adhesive which bonds strongly and quickly may be used" (specification, page 4, lines 21-23).

In our view one of ordinary skill in this art would understand that the terminology "fast acting adhesive," when read in light of the specification, means the adhesive prevents the leading edge of the label from slipping with respect to the container. The reason for preventing the slippage is clear, i.e., to maintain the label in the stretched condition.

Accordingly, in our view "fast acting adhesive" is clear in the context of these claims and we do not sustain the examiner's rejection of appealed claims 1 through 6 and 12

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through 18 under the second paragraph of 35 U.S.C. § 112.

NEW GROUNDS OF REJECTION

Under the authority of 37 CFR § 1.196(b), this panel of the Board introduces the following new grounds of rejection as to claims 1 through 6, 10 and 11.

Claims are considered to satisfy the requirements in the second paragraph of ' 112 if they define the metes and bounds of the claimed subject matter with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

Claims 1 through 6, 10 and 11 are rejected under 35 U.S.C.

§ 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The first step in claim 1 recites the step of "stretching the segment to elastically deform the label..." however there is no antecedent for "the label" and without such antecedent it is not apparent how stretching the segment causes

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deformation of the label.

Although we have rejected claims 1 through 6, 10 and 11 as being indefinite, in the interest of avoiding piecemeal appellate review we will treat claim 1 as though "the label" in step (1) were -- the segment --, and proceed to consider the

§ 103 rejection on that basis. Cf. Ex parte Saceman, 27 USPQ2d 1472, 1474 (Bd. Pat. App. & Int. 1993).

The 35 U.S.C. § 103 rejection of claims 1 through 13 and 15 through 18.

We reverse the rejection of claims 1 through 6, 10 through 13 and 15 through 18 under 35 U.S.C. § 103 as being unpatentable over Dickey in view of Herdzina and we affirm the rejection of claims 7 through 9 under 35 U.S.C. § 103 as being unpatentable over Dickey in view of Herdzina.

Method claim 1 requires, inter alia, the step of applying the leading edge of the "stretched segment" to the article with an adhesive.

A review of the Herdzina reference reveals that

stretching the label onto the article is accomplished by permitting the article to "be rotated at a surface speed considerably in excess of the surface speed of the support surface 66 on which the label is carried" (col. 7, lines 24-26). This suggests to us that at the moment when the leading edge of the label contacts the article there is no stretching of the label, but at a moment later the stretching is begun.

It is the examiner's view that Herdzina teaches stretching the labels and applying them to the container "in a stretched condition" (answer, page 6) and that "[i]t would have been obvious to one having ordinary skill in the art to stretch Dickey's labels in the manner taught by Herdzina" (answer, pages 4-5).

The appellant argues that nothing in Herdzina provides any teaching of how the "stretched" label will be secured to the container (brief, page 5).

In our view the step of applying the stretched segment, as recited in claims 1 and 12, is not taught by Herdzina. We note that claim 1 recites elastically stretching the segment

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and applying "said segment while so stretched to the article...." Thus, the appellant's claim 1 requires stretching prior to applying the label to the article whereas, as noted above, Herdzina teaches the stretching does not begin until a moment after the label is applied to the article. The language in the other independent method claim, claim 12, is similar in that it requires applying and mounting the elastically deformed segment onto the article. In our view Herdzina does not teach or suggest the applying step of appellant's claims 1 and 12. Accordingly, we cannot sustain the examiner's rejection of appealed claims 1 and 12, or of claims 2 through 6, 10, 11, 13 and 15 through 18 which depend therefrom, under 35 U.S.C. § 103.

Turning to the examiner's rejection of article claims 7 through 9, we note that claim 7 recites:

7. An article having a body portion and a segment of sheet material wrapped around it and secured to it, said segment having a leading edge and a trailing edge, said segment being elastic and being in a stretched, elastically deformed condition on the article such that the length of said segment between said leading and trailing edges of said segment on said article is greater than the length between said leading and trailing edges of said segment in a

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relaxed condition,

said leading and trailing edge of said segment being detached from one another or secured together only by adhesive.

It is the appellant's view that article claims 7 through 9 avoid the 35 U.S.C. § 103 rejection over Dickey in view of Herdzina for the same reasons as expressed with respect to the method claims, e.g., that Herdzina does not provide a satisfactory teaching of applying a stretched label as prescribed in appellant's method claims (brief, page 7).

We observe that Herdzina discloses that cans are first heated for accepting labels to be adhered thereto by a heat activated adhesive on the labels (col. 3, lines 28-33). As noted above, the labels may be applied to the cans while stretching the labels, resulting in a stretched label being affixed to each can.

However, although in the Herdzina process the label is stretched when being applied to the can, rather than prior thereto, in each case the resulting article would be a labeled can which satisfies the limitations of the appellant's claim 7. The limitations of claims 8 and 9 are also disclosed by

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Herdzina at, for example, col. 2, lines 66-69 and col. 3, lines 1-2.

Our conclusion that Herdzina satisfies all the limitations of claims 7 through 9 is tantamount to a holding that those claims are anticipated under 35 U.S.C § 102(b). Nevertheless, it is proper to sustain the § 103 rejection because lack of novelty is the epitome of obviousness. See In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

Accordingly, we sustain the examiner's rejection of appealed claims 7 through 9 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 6 and 12 through 18 under 35 U.S.C. § 112 is reversed; a new 35 U.S.C. § 112, second paragraph, rejection of 1 through 6, 10 and 11 is entered pursuant to 37 CFR 1.196(b); the decision of the examiner to reject claims 1 through 6, 10 through 13 and 15 through 18 under 35 U.S.C. §

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103 is reversed; and the decision of the examiner to reject claims 7 through 9 under 35 U.S.C. § 103 is affirmed.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision....

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as

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to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request

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for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

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